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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,175	07/14/2005	Peter Von Matt	NOV-11-US	8299
50446 7590 12/02/2009 HOXIE & ASSOCIATES LLC 75 MAIN STREET, SUITE 301 MILLBURN, NJ 07041				
EXAMINER				
KOSACK, JOSEPH R				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
12/02/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/542,175

**Applicant(s)**

VON MATT ET AL.

**Examiner**

Joseph R. Kosack

**Art Unit**

1626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8, 10, 11, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1, 5-8, and 10-14 are pending in the instant application.

#### ***Amendments***

The amendment filed on August 12, 2009 has been acknowledged and has been entered into the instant application file.

#### ***Previous Claim Objections***

Claim 12 was previously objected to as being dependent upon a rejected base claim.

The claim is still dependent on a rejected base claim, and the rejection is maintained.

#### ***Previous Claim Rejections - 35 USC § 103***

Claims 1-3, 5-8 and 10-11 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Albert et al. (WO 02/38561 A1).

The Applicant has traversed the rejection on the grounds that the compound cited by the Examiner is bicyclic and not monocyclic as required by the claims, does not disclose a method of making the compounds, and the instantly claimed monocyclic compound has more activity than a bicyclic compound.

The Examiner is not persuaded. Firstly, as was shown by the Examiner in the rejection, Albert et al. suggest that monocyclic and bicyclic groups are interchangeable in the compounds and retain the utility of the compound with comparable activity. Additionally, Albert et al. teach a process that the person of ordinary skill in the art would recognize could make the compounds of the instant invention with any R group.

Finally, the IC<sub>50</sub> values that the Applicant has cited, while they are between a monocyclic and a bicyclic compound, are between pyridyl and indolyl compounds which have different functionalities than corresponding pyridyl and isoquinolyl compounds that the Examiner has cited.

Therefore, the Applicant's arguments have been considered, but were not found to be persuasive. The rejection is maintained except for those claims expressly cancelled by the Applicant.

#### ***Claim Objections***

Claims 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 13 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 13 contains compounds where R<sub>2</sub> is hydrogen, which is not allowed by claim 1.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

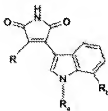
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 5-8, 10, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albert et al. (WO 02/38561 A1).

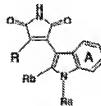
The instant invention is drawn to compounds of the formula

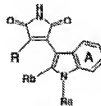


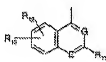
where: R is radical (a); R<sub>1</sub> is piperazine; and all other substituents are

as defined. The instant invention is also drawn to its method of preparation and method of use.

Determination of the scope and content of the prior art (MPEP §2141.01)



Albert et al. teach compounds of the formula  where: A is optionally substituted, Ra is H or optionally substituted C<sub>1-4</sub> alkyl, Rb is H or C<sub>1-4</sub> alkyl, R

is  where G is CH, E is N, R<sub>11</sub> is a heterocyclic residue, and R<sub>12</sub> and R<sub>13</sub> are optional substitutions. See pages 1-2. Albert et al. teaches specifically piperazine in the R<sub>11</sub> substitution. One example is Example 181 on page 33. Albert et al. teaches the same process of forming the compounds. See page 6. Finally, Albert et al. teaches that the compounds are inhibitors of T lymphocytes and/or PKC. See pages 36-40.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Albert et al. teaches an isoquinoline (benzofused pyridine) and not teach a pyridine ring in the R position.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

Albert et al. teaches other monocycles versus the benzofused cycles with no loss of utility and no apparent loss of activity. Specifically, Albert et al. teaches the R position to be phenyl or naphthelene, and pyrimidine or quinazoline. See page 1. Albert et al. also teach that the isoquinoline can be substituted with chlorine. See Example 195 on page 37.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to follow the synthetic scheme of Albert et al. and pyridine for isoquinoline to make the claimed invention with a reasonable expectation of success. The motivation to do so is provided by Albert et al. Albert et al. teach the use of the synthesized compounds to treat various diseases mediated by T lymphocytes and/or PKC and the substitution for benzofused rings for the corresponding monocycles. See page 1 and 36-40.

Thus, the claimed invention as a whole was *prima facie* obviousness over the combined teachings of the prior art.

### **Conclusion**

Claims 1, 5-8, 10, 11, 13, and 14 are rejected. Claims 12 and 13 are objected to.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Kosack whose telephone number is (571)272-5575. The examiner can normally be reached on M-Th 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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